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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER

QM21/0608

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ART UNIT	PAPER NUMBER
3711	MAILED

DATE MAILED: 06/08/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 4-19-99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire -3- month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-44 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-44 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

BEST AVAILABLE COPY

☒ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
☐ Interview Summary, PTO-413
☒ Notice of Draftperson's Patent Drawing Review, PTO-948 (substitute)
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the diverse features now claimed but not apparent to the eye from the drawings, e.g., many process steps and golf ball parameters involving the thickness of some layers, shore D values, "liquid" cores, and specific materials and fillers for cover components, etc. must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what features in the claims are critical, since much is claimed, but little is illustrated on the drawings, thereby obscuring the inventions. For example, none of the specifically claimed process steps or golf ball features are apparent to the eye from the drawings, thereby obscuring a basis on which patentability may be predicated. Claim 39 is a process claim which inaptly depends on claim 36, an article claim. Base claim 14 is inconsistent with the ionomer recited in claim 35. Claim 42 is a confusing blend of process and structural limitations, resulting in an improper hybrid claim.

Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melvin et al (562) or Cavallaro et al (923), each in view of Molitor et al (322). The latter reference renders it obvious to mold the polyurethane layers of the primary reference golf balls by a reaction injection molding process, since such is an obvious expedient for providing the desired resiliency in a golf ball, as illustrated by the secondary reference. Any other possible distinctions over said

thus modified golf balls are deemed conventional molding techniques that would necessarily be used in such molding process.

The restriction requirement of record remain in effect, but will be reconsidered if a claim is found allowable.

No claim is allowed.

George J. Marlo

GEORGE J. MARLO
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ART UNIT 3711

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June 3, 1999